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Remarks:

Regarding the rejection under 35 USC 112, 2nd paragraph of claim 6:

In this paper the applicant amends claim 6 to address the Examiner's rejection; claim 6 has been amended to include a positive process step. The Examiner's attention is directed to applicant's specification which page 7, lines 17-32 discusses the utility of the compositions for household cleaning operations and also discloses exemplary substrates as well as exemplary soils.

Regarding the rejection of claims 1, 3-5, 8-16, 18, 19, 20-22 under 35 USC 103(a) over US 6124253 to Vinci et al (hereinafter "Vinci"):

The applicant respectfully traverses the Examiner's rejection of the claims with regard to the Vinci reference.

Prior to discussing the relative merits of the Vinci reference, the Examiner's attention is directed to claim 1, and the amendments made thereto. Support for these claim amendments may be found in the applicant's specification at page 2 lines 7 – 27 which discusses the unique behavior provided by the applicant's claimed composition.

Turning to the Vinci reference, although the Examiner contends that the presently claimed invention would be arrived at only by trivial modifications of the Vinci reference, the applicant strongly disagrees.

The Vinci composition is directed to a metal cleaning composition which is to be used without agitation to avoid the deleterious effects of foaming at relatively low temperatures, e.g. ambient temperature. More specifically Vinci provides:

"An alkaline, aqueous metal-cleaning composition capable of effectively removing industrial-type soil contaminants from a metal surface at temperatures as low as ambient temperature and in the absence of substantial agitation contains (A) an active-ingredient

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portion containing (1) an alkalinity-providing component, and (2) a surfactant mixture containing: (a) at least one first non-ionic, ethoxylated linear primary alcohol surfactant having a hydrophobic carbon chain length of from 9 to 11 carbon atoms and being ethoxylated with (i) an average of 2.5 moles of ethylene oxide or (ii) an average of 5.0 moles of ethylene oxide; and (b) at least one second non-ionic, ethoxylated linear primary alcohol surfactant having a hydrophobic carbon chain length of from 9 to 11 carbon atoms and being ethoxylated with an average of 6.0 moles of ethylene oxide; and (B) an aqueous portion. "

First, the applicant points out that nowhere in the Vinci reference is there any discussion as to the provision of a "self motile" type composition which is included in the applicant's claims as nowhere does Vinci provide any specific teaching or suggestion as to the necessity of, or the desirability of, providing a composition such as the applicant now claims in presently amended claim 1. Thus, Vinci fails in providing any suggestion or motivation as to provide the types of compositions as applicant now presently claims.

Second, while the Examiner suggests that the currently claimed compositions would be obvious as being the result of "routine experimentation" the applicant strongly traverses the Examiner's position. The applicant takes the position that there is *nothing* in the Vinci reference which would (i) suggest any desirability of selected specific constituents, in specific proportions such that they are present in a chemical equilibrium at or adjacent to a phase boundary such that (ii) loss of 1% or less of one of 1-alkyl-2-pyrrolidone, hydrocarbon, or water would cause a change in the total phases present and induce motility of the composition. Indeed, by routine inspection it is evident that the essential constituents of Vinci are not the same essential constituents required of applicant's claimed invention.

It is the applicant's view that the Examiner's rejection of the claims is in no small part based on a "hindsight reconstruction" of the applicant's invention which is based on a retrospective assemblage of the applicant's claimed invention wherein there lacks an

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appropriate teaching or suggestion. Such is believed to be inappropriate. In *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

It is the applicant's view that the prior art documents cited by the Examiner fail to meet the proper burden of proof, and that the presently presented claims should be allowed.

Regarding the rejection of claims 7 and 17 under 35 USC 103(a) in view of US 6124253 to Vinci, further in view of US 6150318 to Silvester:

The applicant traverses the Examiner's rejection of claims 7 and 17 in view of the combined Vinci and Silvester references.

The Examiner relies upon the Silvester reference to address the further limitations of claims 7 and 17, as respectively Vinci does not discuss a "package" or "bleach" in his reference. With regard to packaging, the applicant concedes that packaging for hard surface treatment compositions is per se, indeed old in the art however the applicant does not concede that the subject matter of presently amended claim 1 is diminished in any way by packaging the same in a container, as the novel and inventive nature of the currently claimed composition is itself patentable, and packaging the same in conventional flask or other container does not diminish the patentability of the composition of claim 1.

With regard to claim 17, as the subject matter of the claim is dependent from claim 1 which is itself believed to be patentable, the dependent claim which suggests the inclusion of bleach should be acknowledged to be patentable itself.

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In addition to the above, the applicant also points out that the Silvester reference fails to teach or suggest in any way suggest any desirability of selecting 1-alkyl-2-pyrrolidone, hydrocarbon, or water and provide these in specific proportions such that they are present in a chemical equilibrium at or adjacent to a phase boundary such that loss of 1% or less of one of 1-alkyl-2-pyrrolidone, hydrocarbon, or water would cause a change in the total phases present and induce motility of the composition. Silvester fails to identify these constituents, and thus cannot be held to suggest the desirability of bleach to a composition which requires such a chemical equilibrium between 1-alkyl-2-pyrrolidone, hydrocarbon, and water.

Accordingly, reconsideration of the propriety of the outstanding rejection of the specification, and of all of the claims is requested.

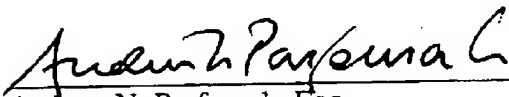
CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

PETITION FOR A TWO-MONTH EXTENSION OF TIME

The applicants respectfully petition for a two-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

Respectfully Submitted;



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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and any indicated enclosures thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-273-8300 on the date shown below:



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